IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Michael Gilfix, *et al.*	§	Group Art Unit: 2623
Serial No.: 10/687,239	§	Examiner: Thomas, Jason M.
Filed: 10/16/03	§	Atty Docket No.: AUS920030360US1
Title: Interactive, Non-intrusive Television Advertising	§	Customer No.: 34533
	§	Confirmation No.: 8992

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P.O. Box 1450
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APPEAL BRIEF

Honorable Commissioner:

This is an Appeal Brief filed pursuant to 37 CFR § 41.37 in response to the Final Office Action of June 27, 2008 (hereinafter the "Office Action"), and pursuant to the Notice of Appeal filed September 25, 2008.

REAL PARTY IN INTEREST

The real party in interest in accordance with 37 CFR § 41.37(c)(1)(i) is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences within the meaning of 37 CFR § 41.37(c)(1)(ii).

STATUS OF CLAIMS

Status of claims in accordance with 37 CFR § 41.37(c)(1)(iii): Forty-two (42) claims are filed in the original application in this case. Claims 1-14 are rejected in the Office Action. Claims 1-14 are on appeal. Claims 15-42 were previously cancelled.

STATUS OF AMENDMENTS

Status of amendments in accordance with 37 CFR § 41.37(c)(1)(iv): No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims that accompanies this Appeal Brief.

SUMMARY OF CLAIMED SUBJECT MATTER

Appellants provide the following concise summary of the claimed subject matter according to 37 CFR § 41.37(c)(1)(v). This summary includes a concise explanation of the subject matter defined in each of the independent claims involved in the appeal and includes references to the specification by page and line number and to the drawings by elements. The independent claim involved in this appeal is claims 1. Claims 1 is a method claim.

Claim 1 recites a method for administering devices (page 24, lines 23-24, and Figure 3). The method of claim 1 includes creating a user metric vector comprising a plurality of disparate user metrics (page 35, lines 7-9, and Figure 6, elements 206, 604, and 606). The method of claim 1 also includes creating a plurality of user metric spaces, each user metric space comprising a plurality of metric ranges (page 38, line 27 – page 39, line 1, and Figure 6, elements 605 and 610). The method of claim 1 also includes selecting,

from the plurality of user metric spaces, a user metric space (page 52, lines 11-12, and Figure 9, elements 610 and 902). The method of claim 1 also includes if the user metric vector is outside the selected user metric space, identifying an action in dependence upon the user metric vector (page 41, line 27 – page 42, line 2, and Figure 6, elements 309, 315, 606, 610, and 612). The method of claim 1 also includes executing the action (page 42, lines 23, Figure 6, elements 312 and 614).

Claim 1 recites a method for delivering interactive non-intrusive advertising content (page 18, lines 11-12; Figure 3). The method of claim 1 also includes receiving a selection signal indicating that a user has selected an item displayed on a television screen, the item included in the television program being displayed, wherein the item has associated non-intrusive interactive advertising content (page 18, lines 11-17; Figure 3, elements 302, 304, and 310). The method of claim 1 also includes responsive to receiving the selection signal, identifying the selected item (page 20, lines 18-19; Figure 3, elements 306 and 316). The method of claim 1 also includes displaying the associated non-intrusive interactive advertising content (page 21, lines 3-4; Figure 3, element 308).

GROUNDS OF REJECTION

In accordance with 37 CFR § 41.37(c)(1)(vi), Appellants provide the following concise statement for each ground of rejection:

1. Claims 1-4, 6-8, and 10 stand rejected under 35 U.S.C. § 102(e) over Broadwin (U.S. Patent 5,929,850).

2. Claims 5, 9, and 11-14 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Broadwin in view of Wistendahl (U.S. Publication No. 2002/0056136 A1).

ARGUMENT

Appellants present the following argument pursuant to 37 CFR § 41.37(c)(1)(vii) regarding the ground of rejection on appeal in the present case.

Argument Regarding The First Ground Of Rejection On Appeal: Claims 1-4, 6-8, and 10 Are Rejected Under 35 U.S.C. §102(e) Over Broadwin

Applicants' claims 1-4, 6-8, and 10 stand rejected under 35 U.S.C. § 102 as being anticipated by Broadwin, *et al.* (U.S. Patent No. 5,929,850) (hereafter 'Broadwin'). To anticipate remaining claims 1-4, 6-8, and 10 under 35 U.S.C. § 102, Broadwin must disclose and enable each and every element and limitation recited in the claims of the present application.

Broadwin Does Not Disclose Each And Every Element Of Independent Claim 1 Of The Present Application

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Independent claim 1 recites:

> 1. A method for delivering interactive non-intrusive advertising content, the method comprising:
>
> receiving a selection signal indicating that a user has selected an item displayed on a television screen, the item included in the television program being displayed, wherein the item has associated non-intrusive interactive advertising content;
>
> responsive to receiving the selection signal, identifying the selected item; and

> displaying the associated non-intrusive interactive advertising content.

As explained in more detail below, Broadwin generally discloses an interactive television system with web-like navigational capabilities. Broadwin does not disclose, however, any of the elements of claim 1 in the present application. Broadwin does not disclose selecting an item that is included in a television program being displayed, and as such, Broadwin cannot possibly disclose the claims of the present application. Broadwin therefore cannot be said to anticipate the claims of the present application within the meaning of 35 U.S.C. § 102. Claim 1 is therefore patentable and should be allowed.

Broadwin Does Not Disclose Selecting An Item Included In The Television Program Being Displayed

The Office Action takes the position that Broadwin at column 3, lines 44-65, column 5, lines 64-66, column 7, lines 52-63, and figures 6, 8, 13, 14, 17, and 18, discloses the following limitation from claim 1 of the present application: receiving a selection signal indicating that a user has selected an item displayed on a television screen, the item included in the television program being displayed, wherein the item has associated non-intrusive interactive advertising content. Applicants respectfully note in response, however, that what Broadwin at column 3, lines 44-65, in fact discloses is:

> The present invention thus comprises an interactive television system with web-like navigational capabilities. As one example, the present invention provides an improved system and method for displaying advertising content in an interactive television system. A user viewing the television can select an option which displays the advertising content of a respective advertiser or vendor. When the user selects this option, the television hyperlinks to one or more high quality compressed video stills which are being broadcast on the dedicated one or more still image channels which display the advertiser's goods or services. In the preferred embodiment, the video stills are presented in a format similar to Internet pages. The still images may include thumbprint images which link to other stills. The user may select respective thumbprints to view a full-screen image of the thumbprint image. Still images may also include a selection which enables the user to order a product or to provide an indication that the user desires to receive more information. The present invention thus enables

> advertisers to more intuitively provide advertising content in an interactive television medium.

And what Broadwin at column 5, lines 64-66 in fact discloses is:

> The television 150 includes a remote control 152 which facilitates user interaction with the television 150 and/or interactive decoder 140.

And what Broadwin at column 7, lines 52-63 in fact discloses is:

> The interactive decoder 140 also includes an input for receiving user input. This user input is provided to an input of the CPU 314. This user input may be provided from various devices, preferably from remote control 152 or from buttons on the TV 150 or the interactive decoder 140. The user input provided to the CPU 314 enables a user to interact with the interactive application. For example, the user or viewer may choose a selection or button displayed on the screen to view a linked still image according to the present invention. The user or viewer may also choose a selection or button to order a product or order information, provide answers to a television game show, etc.

That is, Broadwin at the cited reference points discloses an interactive television system with web-like navigational capabilities. Broadwin's interactive television system with web-like navigational capabilities does not disclose receiving a selection signal indicating that a user has selected an item displayed on a television screen, wherein the item is included in the television program being displayed, and wherein the item has associated non-intrusive interactive advertising content as claimed in the present application because Broadwin does not disclose selecting an item that is included in a television program being displayed. According to the claims of the present invention, a user selects an item that is included in a television program being displayed on a television. Selecting an item that is included in a television program being displayed may include, for example, selecting the sweater worn by a particular character in a television program. *See*, Applicants' original specification at page 3, lines 12-18. In contrast to the claims of the present application, Broadwin describes an interactive television system that merely displays "selection options which reference or link to MPEG stills." Broadwin at column 2, lines 47-50. That is, Broadwin only discloses that a user is allowed to make a selection

from 'selection options' on a screen. Broadwin at the reference points cited in the Office Action and all other reference points, however, does not disclose that a 'selection option' is an item that is included in a television program. In fact, Broadwin at column 17, lines 34-47 discloses that a 'selection option' may take the form of thumbprint images – not items that are included in a television program. Because Broadwin does not disclose each and every element and limitation of Applicants' claims, Broadwin does not anticipate Applicants' claims, and the rejections under 35 U.S.C. § 102 should be withdrawn.

In the response to arguments section, the Office Action takes the position that Broadwin at the abstract column 2, lines 52-56, column 5, line 53 - column 6, line 10, column 6, lines 50-67, column 9, lines 49-60, column 1, lines 54-56, and column 10, lines 22-28 discloses receiving a selection signal indicating that a user has selected an item displayed on a television screen, the item included in the television program being displayed. Appellants note in response, however, that what Broadwin at the cited reference points in fact discloses is selections that are overlaid on top of the normal program. The selections of Broadwin are not included in the program. Because Broadwin's selections are not included in the program, Broadwin cannot disclose receiving a selection signal indicating that a user has selected an item displayed on a television screen, the item included in the television program being displayed, as claimed in the present application. Because Broadwin does not disclose each and every element and limitation of Applicants' claims, Broadwin does not anticipate Applicants' claims, and the rejections under 35 U.S.C. § 102 should be withdrawn.

Broadwin Does Not Enable Each and Every Element Of The Claim Of The Present Application

Not only must Broadwin disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Broadwin must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the

Appellant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Broadwin places Applicants' claims in the possession of a person of ordinary skill in the art, Broadwin is legally insufficient to anticipate Applicants' claims under 35 U.S.C. § 102. As explained above, Broadwin does not disclose each and every element and limitation of independent claim 1 of the present application. Because Broadwin does not disclose each and every element and limitation of the independent claim, Broadwin cannot possibly place the elements and limitations of the independent claim in the possession of a person of ordinary skill in the art. Broadwin cannot, therefore, anticipate claim 1 of the present application.

Relations Among Claims

Claims 2-4, 6-8, and 10 depend from independent claim 1. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because Broadwin does not disclose or enable each and every element of the independent claim 1, Broadwin does not disclose or enable each and every element of the dependent claims of the present application. As such, claims 2-4, 6-8, and 10 are also patentable and should be allowed.

Argument Regarding The Second Ground Of Rejection On Appeal:
Claims 5, 9, and 11-14 Are Rejected Under 35 U.S.C. §103(a)
Over Broadwin In View Of Wistendahl

Claims 5, 9, and 11-14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Broadwin in view of Wistendahl, *et al.* (U.S. Publication No. 2002/0056136) (hereafter, 'Wistendahl'). The question of whether Applicants' remaining claims are obvious or not is examined in light of: (1) the scope and content of the prior art; (2) the differences

between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 2 (U.S. April 30, 2007). Although Applicants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a prima facie case of obviousness to reject Applicants' claims for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). To establish a prima facie case of obviousness, the proposed combination of the references must teach or suggest all of the claim limitations of dependent claims 5, 9, and 11-14. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Claims 5, 9, and 11-14 depend from independent claim 1 and include all the limitations of independent claim 1. In rejecting dependent claims 5, 9, and 11-14, the Office Action relies on Broadwin as disclosing each and every element of independent claim 1. As shown above, Broadwin does not disclose each and every element of independent claim 1. Because Broadwin does not disclose each and every element of independent claim 1, the combination of Broadwin and Wistendahl cannot possibly disclose each and every element of dependent claim 5, 9, and 11-14. The proposed combination of Broadwin and Wistendahl, therefore, cannot establish a prima facie case of obviousness, and the rejections 35 U.S.C. § 103(a) should be withdrawn.

Conclusion of Appellants' Arguments

Claims 1-4, 6-8, and 10 stand rejected under 35 U.S.C. § 102 as being anticipated by Broadwin. Broadwin does not disclose or enable each and every element of Applicants' claims. Broadwin therefore does not anticipate Applicants' claims. Claims 1-4, 6-8, and 10 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1-4, 6-8, and 10.

Claims 5, 9, and 11-14 stand rejected under 35 U.S.C. § 103 as obvious over a combination of Broadwin and Wistendahl. The combination of Broadwin and Wistendahl does not teach or suggest each and every element of Applicants' claims. Claims 5, 9, and

11-14 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 5, 9, and 11-14.

In view of the arguments above, reversal on all grounds of rejection is requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: November 25, 2008 By:

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APPENDIX OF CLAIMS
ON APPEAL IN PATENT APPLICATION OF
MICHAEL GILFIX, SERIAL NO. 10/687,239

CLAIMS

What is claimed is:

1. A method for delivering interactive non-intrusive advertising content, the method comprising:

receiving a selection signal indicating that a user has selected an item displayed on a television screen, the item included in the television program being displayed, wherein the item has associated non-intrusive interactive advertising content;

responsive to receiving the selection signal, identifying the selected item; and

displaying the associated non-intrusive interactive advertising content.

2. The method of claim 1 further comprising receiving and storing advertising data that associates the selected item with a screen region and with interactive advertising content.

3. The method of claim 2 wherein receiving the advertising data comprises receiving the advertising data encoded in a video signal that includes a video image of the item.

4. The method of claim 2 wherein the advertising data is encoded in a digital data stream separate from a video signal and receiving the advertising data comprises receiving the data stream through a digital network.

5. The method of claim 2 wherein the advertising data includes instructions for control of the display of interactive non-intrusive advertising content for the item.

6. The method of claim 1 further comprising:

receiving one or more designation signals, wherein each designation signal represents an instruction to designate an item having associated non-intrusive interactive advertising content;

responsive to receiving each designation signal, designating singly, as a currently designated item, each of a multiplicity of items having associated non-intrusive interactive advertising content;

wherein identifying the selected item comprises identifying as the selected item the currently designated item.

7. The method of claim 6 wherein designating singly each of a multiplicity of items further comprises logically designating an item and visually designating an item.

8. The method of claim 7 wherein logically designating an item comprises setting a designation data element in advertising data for the item.

9. The method of claim 7 wherein visually designating an item comprises displaying descriptive text for the item.

10. The method of claim 7 wherein visually designating an item comprises changing a video display of the item.

11. The method of claim 1 further comprising tracking a cursor position on the television screen, wherein identifying the selected item comprises identifying the selected item in dependence upon the cursor position when the selection signal is

received.

12. The method of claim 1 wherein identifying the selected item in dependence upon the cursor position further comprises determining whether the cursor position is within a screen region associated with the item.

13. The method of claim 1 wherein the interactive advertising content comprises a web page describing the item and offering an on-line sale of the item.

14. The method of claim 1 wherein displaying the associated non-intrusive interactive advertising content comprises downloading a web page from a remote web site identified in a link associated with the selected item.

Claims 15-42. (Cancelled)

APPENDIX OF EVIDENCE ON APPEAL IN PATENT APPLICATION OF MICHAEL GILFIX, SERIAL NO. 10/687,239

This is an evidence appendix in accordance with 37 CFR § 41.37(c)(1)(ix).

There is in this case no evidence submitted pursuant to 37 CFR §§ 1.130, 1.131, or 1.132, nor is there in this case any other evidence entered by the examiner and relied upon by the Appellants.

RELATED PROCEEDINGS APPENDIX

This is a related proceedings appendix in accordance with 37 CFR § 41.37(c)(1)(x). There are no decisions rendered by a court or the Board in any proceeding identified pursuant to 37 CFR § 41.37(c)(1)(ii).